



UNITED STATES PATENT AND TRADEMARK OFFICE

CLC
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,306	03/23/2001	Wen Y. Chen	035879/0120	4654

22428 7590 10/21/2005

FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

YAEN, CHRISTOPHER H

ART UNIT	PAPER NUMBER
----------	--------------

1643

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/815,306

Applicant(s)

CHEN ET AL.

Examiner

Christopher H. Yaen

Art Unit

1643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,22,28,29,33-39,45-47,51-54 and 56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,22,28,29,33-39,45-47,51-54 and 56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

RE: Chen *et al*

1. Upon further review and reconsideration, the finality of the previous Office action is hereby withdrawn in view of the new arguments presented herein.
2. The after final amendment submitted 8/29/2005 is entered.
3. Claims 2,7-21, 23-27, 30-32, 40-44, 48-50, 55, and 57-60 are canceled without prejudice or disclaimer.
4. Claims 1,3-6,22,28-29,33-39,45-47,51-54, and 56 are pending and examined on the merits.

NEW ARGUMENTS

Claim Rejections - 35 USC § 112, 1st paragraph

5. Claims 1,3-6,22,28,35-39,45-46, 51-54, and 56 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The written description in this case has only set forth a method of treating cancer comprising the administration of a prolactin receptor antagonizing domain of SEQ ID No: 1 with a substitution at amino acid position 157 or a prolactin receptor antagonizing domain wherein the domain comprises a G129R mutation; and a positive immunomodulatory domain, wherein the domain is a cytokine, and therefore the written description is not commensurate in scope to the claims that read on a method of

Art Unit: 1643

administering any and all prolactin antagonizing domain and an immunomodulatory domain of a cytokine as claimed. The following *written description* rejection is set forth herein.

Vas-Cath Inc. V. Mahurkar, 19 USPQ2d 1111, clearly states that “applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*. The invention is, for purposes of the ‘written description’ inquiry, *whatever is now claimed*.” (See page 1117). The specification does not “clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed.” (See *Vas-Cath* at page 1116). Applicant is reminded that *Vas-Cath* makes clear that the written description provision of 35 USC 112 is severable from its enablement provision (see page 115).

The claims recite a prolactin receptor antagonizing domain as part of the invention. However, there does not appear to be an adequate written description in the specification as-filed of the essential structural within the prolactin domain that features the recited function of antagonizing prolactin as broadly claimed. The Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, ¶ 1 “Written Description” Requirement make clear that the written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice, reduction to drawings, or by disclosure of relevant, identifying characteristics, i.e., structure or other physical and or chemical properties, by functional characteristics coupled with a known or disclosed correlation between function and structure, or by a combination of such identifying characteristics, sufficient

Art Unit: 1643

to show the applicant was in possession of the genus (Federal Register, Vol. 66, No. 4, pages 1099-1111, Friday January 5, 2001, see especially page 1106 3rd column).

Applicant does not appear to have reduced to practice a prolactin antagonizing domain using the broad scope of any portion of the prolactin sequence of SEQ ID No: 1 as claimed. The specification teaches on page that position 157 of SEQ ID No: 1 or position 129 of the mature protein is the critical amino acids that causes antagonistic activity of prolactin (see page 13-14, for example). Specifically, applicant indicates that a "G129R" modification at amino acid position 129 is critical for the antagonistic activity. Applicant has not provided a sufficient written description of any other domain structure with SEQ ID No: 1 that may be correlated with the desired antagonistic function. Thus the genus of domains encompassed by the term prolactin antagonistic domain is extensive and the artisan would not be able to recognize that Applicant was in possession of the invention as now claimed.

Consequently, Applicant was not in possession of the instant claimed invention. See Regents of the University of California v. Eli Lilly and Co. 119 F.3d 1559, 43 USPQ2d 1398 (Fed. Cir. 1997). Adequate written description of genetic material "requires a precise definition, such as by structure, formula, chemical name, or physical properties,' not a mere wish or plan for obtaining the claimed chemical invention." Id. 43 USPQ2d at 1404 (quoting Fiers, 984 F.2d at 1171, 25 USPQ2d at 1606). The disclosure must allow one skilled in the art to visualize or recognize the identity of the subject matter of the claim. Id. 43 USPQ2d at 1406. A description of what the genetic material does, rather than of what it is, does not suffice. Id.

Art Unit: 1643

While it is noted that the instant claims are drawn to methods, the claims nevertheless require an adequate written description of the "TCCR antagonist" employed in the methods. Applicant is directed to the Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, ¶ 1 "Written Description" Requirement, Federal Register, Vol. 66, No. 4, pages 1099-1111, Friday January 5, 2001. Applicant is invited to point to clear support or specific examples of the claimed invention in the specification as-filed.

Claim Rejections - 35 USC § 112, 2nd paragraph

6. Claims 33 and its dependents are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The sequence listing submitted 3/23/2001 indicates that amino acid position 129 of SEQ ID No: 1 is a Glutamic acid (Glu) and is not Glycine (Gly). Thus it indefinite what the applicant is intending to claim. Note: the specification indicates that amino acid position 129 is a Glycine.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher H. Yaen whose telephone number is 571-272-0838. The examiner can normally be reached on Monday-Friday 9-5.

Art Unit: 1643

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms, Ph.D. can be reached on 571-272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher Yaen
Art Unit 1643
October 17, 2005



LARRY R. HELMS, PH.D.
SUPERVISORY PATENT EXAMINER